

REMARKS

Applicant acknowledges receipt of the Final Office Action mailed November 24, 2008.

Applicant would like to thank the Examiner for conducting a telephonic interview with Applicant's representatives on February 20, 2009. During the interview, Applicant's representatives discussed the 35 U.S.C. § 112, first paragraph, rejections; independent claims 9 and 11; and the *Fukushima* (U.S. Patent No. 7,065,570) reference. In response to the interview, Applicant submits herewith further arguments explaining how the pending claims are patentably distinguishable over the cited prior art.

In the Final Office Action, the Examiner objected to the drawings; rejected claims 9-12 under 35 U.S.C. § 112, first paragraph; and rejected claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over *Fukushima* in view of *Spira et al.* (U.S. Patent No. 7,269,569).

In this Amendment, Applicant proposes to amend claims 9-12. Upon entry of this Amendment, claims 9-12 will remain pending. Of these claims, claims 9 and 11 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claims 9-12. No new matter has been introduced.

Applicant traverses the objection and rejections above and respectfully requests reconsideration for at least the reasons that follow.

I. OBJECTIONS TO THE DRAWINGS

The drawings stand objected to under 37 C.F.R. § 1.83(a). Specifically, the Examiner asserts that "the features recited in claims 9-12 such as an alarming step . . . ,

and generating a predetermined alarm . . . , an operating time detecting step . . . , and computing an index value . . . must be shown or the feature(s) canceled from the claim(s)." (*Final Office Action*, p. 2, para. 4). Applicant respectfully submits that the objections to the drawings have been rendered moot by the amendments to claims 9 and 11.

All of the features identified above, for example, are supported by the drawings as follows:

- (a) "an alarming step": claim 9, and similarly claim 11, has been amended to recite "a notification step," support for which may be found, for example, in the steps outlined in FIG. 13.
- (b) "generating a predetermined alarm": claim 9, and similarly claim 11, has been amended to recite "generating a notification by an output unit," support for which may be found, for example, in the steps outlined in FIG. 13.
- (c) "an operating time detecting step": support may be found, for example, in the steps outlined in FIG. 13.
- (d) "computing an index value": claim 9, and similarly claim 11, has been amended to recite "computing a quantified productivity of the machine," support for which may be found, for example, in step S42 outlined in FIG. 15.

Applicant respectfully requests that the objections to the drawings be withdrawn.

II. 35 U.S.C. § 112, FIRST PARAGRAPH, REJECTIONS

Claims 9-12 stand rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts that the limitations “data acquisition unit,” “an alarming unit,” “generating a predetermined alarm by an output unit,” and “computing an index value,” are not supported by the specification. (*Final Office Action*, p. 3, para. 6). Applicant respectfully disagrees and submits that the rejections of claims 9-12 have been rendered moot by the amendments to claims 9 and 11.

All of the limitations identified above, for example, are supported by the specification as follows:

- (a) “data acquisition unit”: see the disclosure with respect to the “central processing unit 127” on page 9, line 25 - page 10, line 16, and page 20, ll. 18-19 of the specification; and FIG. 13 (step S21).
- (b) “an alarming unit”: claim 11, and similarly claim 9, has been amended to recite “a notification unit,” support for which may be found, for example, on page 21, line 8 - page 22, line 9 of the specification.
- (c) “generating a predetermined alarm by an output unit”: claim 11, and similarly claim 9, has been amended to recite “generates a notification by an output unit,” support for which may be found, for example, on page 21, line 8 - page 22, line 9 of the specification.
- (d) “computing an index value”: claim 9, and similarly claim 11, has been amended to recite “computing a quantified productivity of the machine,” support for which may be found, for example, on

page 25, line 27 - page 26, line 4 of the specification; and FIG. 15
(step S42).

Applicant respectfully requests that the rejection of claims 9-12 under 35 U.S.C. § 112, first paragraph, be withdrawn.

III. 35 U.S.C. § 103(a) REJECTION

Applicant traverses the rejection of claims 9-12 under 35 U.S.C. § 103(a) as being unpatentable over *Fukushima* in view of *Spira*. Applicant respectfully disagrees with the Examiner's arguments and conclusions and submits that amended independent claims 9 and 11 are patentably distinguishable over *Fukushima* and *Spira* at least for the reasons described below.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention." M.P.E.P. § 2145. Furthermore, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole

would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Fukushima appears to disclose a management system for managing maintenance contracts for a machine, including a maintenance rank table organized by model; an input means that enters a model of a machine that makes a maintenance contract, a contract rank, and a maintenance actual result value; a means for storing a maintenance actual result value; and a determination means that determines whether a maintenance actual result value is larger than a maintenance predicted value. (*Fukushima*, col. 5, ll. 23-51).

As admitted by the Examiner, “*Fukushima*, as applied above shows all of the limitations of the claims except for specif[ically] acquiring, by a sensor, operation condition data representing a physical quantity indicating an operation condition, and an alarming step . . . , and generating a predetermined alarm by an output unit when determining that the machine is abnormal.” (*Final Office Action*, p. 4, para. 5).

Furthermore, *Fukushima* does not disclose at least “a **quantifying step** of computing a quantified productivity of the machine over the predetermined service

period; a **comparing step** of comparing by a comparing unit the quantified productivity of the machine in the quantifying step with a predetermined productivity reference to compute a difference between the quantified productivity and the reference productivity; and a **charge amount determining step** of reading charge information for converting the difference between the quantified productivity of the machine and the reference productivity from a charge reference value storage unit and determining an amount of charge for the maintenance service in the service period based on a difference between the charge information and the difference computed by the comparing unit in the comparing step," as recited in independent claim 9, and similarly independent claim 11.

Rather, as disclosed in col. 6, lines 4-17 of *Fukushima*, "if the maintenance actual result value is significantly lower than the maintenance predicted value, it is considered that the maintenance-receiving side pays too much. Thus, any profit may be returned to the maintenance-receiving side by means of a dividend payment, extension of maintenance contract time period or maintenance contract term, a cut at the time of a following maintenance contract, or the like. On the other hand, if the maintenance actual result value substantially exceeds the maintenance predicted value, it is loss of the maintenance-providing side. Thus, any profit may be returned to the maintenance-providing side by the re-examination of the contract rank, the increase of payment, or the like at the time of making a following maintenance contract." As further stressed in *Fukushima*, the above-identified method/procedure has been implemented such that "the burden of the both sides that make a maintenance contract can be properly

adjusted” and “any negotiation at the time for a future maintenance contract can also be performed easily.” (*Id.* at col. 6, ll. 17-23).

This does not disclose and is quite different from Applicant’s claimed invention, which includes a charge amount determining step / a charge amount determination unit that reads charge information for converting the difference between the quantified productivity of the machine and the reference productivity from a charge reference value storage unit and determines an amount of charge for the maintenance service in the service period based on a difference between the charge information and the difference computed by the comparing unit. That is, in Applicant’s present invention, the amount of payment for the maintenance service of the machine is based on the difference between the quantified productivity of the machine calculated after the maintenance service and the reference productivity of the machine calculated during operation in the preliminary period. Whereas in *Fukushima*, a dividend, an extension of a maintenance contract time period, or an increase in payment (i.e., the amount of payment) is calculated based on the difference between the maintenance predicted value and the maintenance actual value.

In order to cure the deficiencies of *Fukushima*, the Examiner relies on *Spira* and alleges “*Spira* teaches acquiring, by a sensor, operation condition data representing a physical quantity indicating an operation condition . . . , and an alarming step . . . , and generating a predetermined alarm by an output unit . . .” (*Final Office Action*, p. 5, ll. 16-22).

Such teaching, even if present in *Spira*, with Applicant does not concede, fails to teach or suggest at least “a **quantifying step** of computing a quantified productivity of

the machine over the predetermined service period; a **comparing step** of comparing by a comparing unit the quantified productivity of the machine in the quantifying step with a predetermined productivity reference to compute a difference between the quantified productivity and the reference productivity; and a **charge amount determining step** of reading charge information for converting the difference between the quantified productivity of the machine and the reference productivity from a charge reference value storage unit and determining an amount of charge for the maintenance service in the service period based on a difference between the charge information and the difference computed by the comparing unit in the comparing step," as recited in independent claim 9, and similarly independent claim 11.

As explained above, the elements of independent claims 9 and 11 are neither taught nor suggested by the cited references. Consequently, the Final Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the claimed invention. Accordingly, no reason has been clearly articulated as to why the claims would have been obvious to one of ordinary skill in view of the prior art. Therefore, a *prima facie* case of obviousness has not been established for independent claims 9 and 11. Claims 9 and 11, and corresponding dependent claims 10 and 12, are therefore patentable over *Fukushima* in view of *Spira*. Applicant therefore requests that the rejection of claims 9-12 under 35 U.S.C. § 103(a) be withdrawn.

IV. "RESPONSE TO ARGUMENTS" SECTION

On page 6 of the Final Office Action, under the "Response to Arguments" heading, the Examiner asserts that the "[o]bjection to the IDS filed on March 10, 2005,

as detailed in previous action, has not been overcome. The 'concise statement of relevance' referred to by the applicant in the argument filed on February 26, 2008 has not been received." Applicant respectfully disagrees.

As pointed out to the Examiner during the telephonic interview on February 20, 2009, public PAIR shows that a copy of the "concise statement of relevance" was attached to page 7 of "Applicant Arguments/Remarks Made in an Amendment" filed on February 26, 2008. Accordingly, Applicant respectfully requests that the Examiner review the "concise statement of relevance" and enter and consider the IDS filed on March 10, 2005.

V. CONCLUSION

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 9-12 in condition for allowance. Applicant submits that the proposed amendments of claims 9-12 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the Amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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